

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:
BRUCE L. ADAMS
ADAMS & WILKS
50 BROADWAY-31ST FLOOR
NEW YORK, NY 10004

Date of mailing
(day/month/year) **28 FEB 2005**

Applicant's or agent's file reference
D011-4740(PC)

FOR FURTHER ACTION
See paragraph 2 below

International application No. PCT/US04/25849	International filing date (day/month/year) 10 August 2004 (10.08.2004)	Priority date (day/month/year) 12 August 2003 (12.08.2003)
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International Patent Classification (IPC) or both national classification and IPC

IPC(7): B26B 3/00, 11/00; B25F 1/00; B43L 7/00, 9/04, 13/00, 13/02, 13/24 and US Cl.: 7/158, 164; 33/19.1-19.3, 27.031-27.033, 32.1-32.3, 41.1, 419, 425, 427; 30/138

Applicant
MCCREESH, RORY

1. This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input checked="" type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230	Authorized officer <i>Sharon A. Greenough</i> David B. Thomas Telephone No. (571) 272-3700
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Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

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Box No. V Reasoned statement under Rule 43 *bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>Please See Continuation Sheet</u>	YES
	Claims <u>Please See Continuation Sheet</u>	NO
Inventive step (IS)	Claims <u>Please See Continuation Sheet</u>	YES
	Claims <u>Please See Continuation Sheet</u>	NO
Industrial applicability (IA)	Claims <u>Please See Continuation Sheet</u>	YES
	Claims <u>Please See Continuation Sheet</u>	NO

2. Citations and explanations:

Please See Continuation Sheet

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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

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Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

V.1. Reasoned Statements:

The opinion as to Novelty was positive (Yes) with respect to claims 6, 10-20, 22-26, 28-30, 32-34, 36, and 37

The opinion as to Novelty was negative (No) with respect to claims 1-5, 7-9, 21, 27, 31, and 35

The opinion as to Inventive Step was positive (Yes) with respect to claims 10, 15, 18, 19, 24, 25, 28, 29, 32, 33, and 36

The opinion as to Inventive Step was negative (NO) with respect to claims 1-9, 11-14, 16, 17, 20-23, 26, 27, 30, 31, 34, 35, 37

The opinion as to Industrial Applicability was positive (YES) with respect to claims 1-37

The opinion as to Industrial Applicability was negative (NO) with respect to claims NONE

V. 2. Citations and Explanations:

Claims 1-5 and 21 lack novelty under PCT Article 33(2) as being anticipated by BRAUN (6,286,216). BRAUN discloses a "multi-purpose" tool for making circular cuts, the tool comprising a first member 28 having a first and second portion, a second member 40, where the second member 40 is pivotally and slidably coupled to the first member via a threaded releasable locking member and a boss 50 through an elongate slot 48 in the first member, the second member being adjustable in order to provide arcs of different dimensions (see Fig. 2).

Claims 1-5, 7-9, 21, 27, 31, and 35 lack novelty under PCT Article 33(2) as being anticipated by SILVER (2,557,699). SILVER discloses a multi-purpose hand tool having a first member having a first and a second portion; a second member slidably and pivotally coupled to the second portion of the first member; a coupling assembly; means for pivotally coupling the second member to the first; the coupling means comprising a boss and a releasable locking mechanism, the locking mechanism having a knob with a threaded joint and fastener; the first member including a cutout region to afford sliding movement between the first and the second member; and a retractable needle assembly.

Claim 20 lacks an inventive step under PCT Article 33(3) as being obvious over BRAUN. BRAUN teaches (Col. 8, lines 23-34) that the device is preferably made of a plastic material, and further teaches that at least the pressure disc is formed of transparent or at least translucent plastic material, such that a user may be able to see through the disc to the material that the device is used upon, therefore, it would have been obvious, upon the suggestion that "at least the pressure disc is formed of transparent material", to make the entire device of BRAUN of transparent material.

Claims 6, 16, 17, 22, and 23 lack an inventive step under PCT Article 33(3) as being obvious over SILVER (2,557,699) in view of WARWICKER (GB 2155406 A). SILVER discloses the invention as claimed, except for the provision of a sharpener and "color coded" measuring scales. WARWICKER discloses a ruler, which inherently includes measuring scales, and teaches among other features, that it would be desirable to provide such device with a pencil sharpener. The examiner notes that claim 17 merely recites the limitation that the measuring scales are "color-coded", which is limiting in the sense that further defines the measuring scale of claim 16, however, "color" is not a structure, and as such the examiner takes official notice that among the art of measuring and indication, the use of color-coded measurement scales is well known. The examiner also respectfully contends that the device of SILVER inherently relies upon some sort of measurement function in the use of the device, although SILVER is not explicit. Furthermore, the examiner considers the device of SILVER and the device of WARWICKER as equivalents in the art, as each device is used for measurement, marking, or as a layout device. Therefore, it would have been obvious to one having ordinary skill in the art of measuring and scribing, to have modified the multi-purpose tool of SILVER by providing measuring scales, in order to provide a user of the tool the means to select appropriate positions for the retractable needle assembly prior to use, or in order to assess a measurement after employing the tool, and further providing a pencil sharpener on the tool, such as taught by WARWICKER, wherein the provision of the pencil sharpener serves to provide a convenient means of maintaining a sharp point on a pencil used with the device.

Claims 11-14 lack an inventive step under PCT Article 33(3) as being obvious over SILVER (2,557,699) in view of DECKER

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Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

(4,656,744). SILVER discloses the invention as claimed, except for explicitly providing a marking pencil rest. DECKER discloses a scribing tool. DECKER teaches the provision of a slidable marking pencil rest means for the scribing device, the purpose of which is to provide a secure means for maintaining the position of the pencil relative to the scribe during use. Therefore, it would have been obvious to one having skill in the art at the time the invention was made to have modified the multi-purpose scribing tool of SILVER by providing a slidable marking pencil rest means on the tool, as DECKER teaches that the provision of a pencil rest on a scribing tool provides an improved arrangement for effecting the accurate marking of irregular contact lines on wall panels and the like.

Claims 20, 26, 30, 34, and 37 lack an inventive step under PCT Article 33(3) as being obvious over SILVER (2,557,699) in view of JOHNSON (6,134,796). SILVER discloses the invention as claimed, except for the provision of the first and second members being fabricated from a transparent material. JOHNSON discloses a navigational plotter, the plotter having a plurality of plotter arms rotatably and removably connected to a central hub. The plotter of JOHNSON is similar to the scribing device of SILVER, in that each are used for measuring and marking. JOHNSON teaches that the apparatus may be made of wood, thick transparent material, or other construction. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the scriber of SILVER, by forming the scriber, in part or whole, of a transparent material, wherein the fabrication of a device of a particular material that is desirable for the intended use, in this case a transparent material such that a user may see through the device to the material below the device, would have been within the level of ordinary skill of the artisan, and evidenced by JOHNSON.

Claims 10, 15, 18, 19, 24, 25, 28, 29, 32, 33, and 36 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest a cavity for receiving the head portion of stem of the finger-engagement portion; gripping means that comprises a plurality of ribs; or a pair of through holes.

Claims 1-37 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments and any accompanying statement, under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the time of filing the amendments (and any statement) with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments (and of any statement) and, where required, a translation of such amendments for the procedure before that Authority (see Rules 55.3(a) and 62.2, first sentence). For further information, see the Notes to the demand form (PCT/IPEA/401).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see the *PCT Applicant's Guide*, Volume II.